

REMARKS**Summary of the Office Action**

In the Office Action, claims 1-5 and 16-19 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,523,989 to Ishibashi (hereinafter "Ishibashi").

Claims 1, 2, 5-11 and 16-22 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,507,544 to Ma et al. (hereinafter "Ma").

Claims 12-15, while objected to as being dependent upon a rejected base claim, are indicated as being allowable if rewritten in independent form.

Summary of the Response to the Office Action

Applicants have filed a verified English translation of Japanese priority document (Japanese Patent Application No. 2000-237691). Claims 1-3 and 16-19 have been canceled without prejudice or disclaimer. Claims 4, 6 and 20 have been amended to place them in independent form by incorporating their respective independent claims. As a result of these amendments, the dependencies of claims 5, 10 and 11 have been changed. Accordingly, claims 4-15 and 20-22 are now pending in this application.

Rejections under 35 U.S.C. § 102**Ma**

Claims 1, 2, 5-11 and 16-22 are rejected under 35 U.S.C. § 102(e) as being anticipated by Ma. Applicants respectfully submit that Ma should not be considered as prior art in the present application under any subsection of 35 U.S.C. § 102. On November 5, 2001, Applicants filed a

Claim for Priority and a Certified copy of Japanese Patent Application No. 2000-237691 which was filed in Japan on August 4, 2000. Pursuant to 37 C.F.R. § 1.55(a), Applicants submit concurrently herewith a verified translation of Japanese Patent Application No. 2000-237691. The U.S. filing date of Ma is September 15, 2000 which is after the priority date to which this application is entitled. Accordingly, Applicants respectfully submits that Ma should not be considered as prior art in the present application under any subsection of 35 U.S.C. § 102.

Ishibashi

Claims 1-5 and 16-19 are rejected under 35 U.S.C. § 102(b) as being anticipated by Ishibashi. Claims 1-3 and 16-19 have been canceled without prejudice or disclaimer. Claims 6 and 20 have been amended to place them in independent form by incorporating the limitations of their respective independent claims. As a result of these amendments, the dependencies of claims 10 and 11 have been changed. Original dependent claims 6 and 20 were not rejected under Ishibashi. As these claims have now been rewritten in independent form, and no other art rejection currently applies to these claims, as discussed above, Applicants respectfully submit that new independent claims 6 and 20 are in condition for allowance. Dependent claims 7-15 and 21-22 are in condition for allowance at least because of their dependency from either of amended claims 6 and 20. Moreover, the Examiner is thanked for the indication that dependent claims 12-15, while objected to as being dependent upon a rejected base claim, include allowable subject matter. In light of the foregoing discussion, withdrawal of the objection of these claims is respectfully requested.

Claim 4 has been amended to place it in independent form by incorporating the limitations of its independent claim 1. As a result of this amendment, the dependency of claim 5

has been changed to be dependent on amended claim 4. While the Office Action had rejected dependent claims 4 and 5 as being anticipated by Ishibashi, that rejection is respectfully traversed for the following reasons.

With regard to claim 4, the Office Action, at page 3, asserts that Figs. 1-6 of Ishibashi show an optical pickup apparatus which has photo-detecting elements arranged in a tangential direction of the recording medium. However, Applicants respectfully submit that the photo-detecting elements (5a, 5b, 6a, 6b) of Ishibashi are arranged in a “radial” direction of the recording medium as shown in Fig. 1. This difference in arrangement can also be understood by comparing the arrangement of the photo-detecting elements (5a, 5b, 6a, 6b) and 4a, 4b in Fig. 1 of Ishibashi with Figs. 2, 4 and 21 of the present application.

More specifically, Applicants respectfully submit that the elements 4a and 4b of Ishibashi are minute prisms for guiding interference beams to the photo-detecting elements 6a, 6b, respectively. Thus, the elements 4a, 4b correspond, for example, to the interference beam pattern as shown in Fig. 2B of Ishibashi. The elements 4a, 4b are arranged in a “radial” direction of the recording medium, as shown in Fig. 1 of Ishibashi. Moreover, the photo-detecting elements (5a, 5b, 6a, 6b) are also arranged in a “radial” direction.

On the other hand, in disclosed embodiments of the instant application, the three photo-detecting elements L1-L3 or R1-R3 are arranged in a “tangential” direction as shown, for example, in Fig. 2 of the instant application. The arrangement relation between the three photo-detecting elements R1-R3 and the interference beam pattern is even more evident by referring to Fig. 21 of the instant application. As a result, Applicants respectfully submit that the specific

configuration recited in newly-amended independent claim 4 is neither disclosed nor suggested in Ishibashi.

Applicants respectfully assert that the rejection of claim 4 under 35 U.S.C. § 102(b) should be withdrawn because Ishibashi does not teach or suggest each feature of independent claim 4, as amended. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)." Furthermore, Applicants respectfully assert that dependent claim 5 is allowable at least because of its dependence from independent claim 4, as amended, and the reasons set forth above.

CONCLUSION

In view of the foregoing, Applicants respectfully request the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required,